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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,618	04/13/2001	Tarou Kanamori	206171US0	3729 14

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EXAMINER

ROBERTSON, JEFFREY

ART UNIT	PAPER NUMBER
1712	

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No:	Applicant(s)
	09/833,618	KANAMORI ET AL.
	Examiner	Art Unit

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 7/7/67.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) \_\_\_\_\_ is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 1,2,4,5,7,9-17,20-26,28,31,32 and 35 is/are allowed.

6) Claim(s) \_\_\_\_\_ is/are rejected.

7) Claim(s) 8,9,18,19,27,29,30,33,34,36 and 37 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a))

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ .                    6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 8, 19, 27, 29, 34, and 36 are objected to because of the following informalities: for claim 8, in line two of the claim, prior to the last amendment, "anyone" was originally present in the claim as two words. It should have been objected to in the previous office action. For claims 19, 27, 29, 34, and 36, this same problem exists. "anyone" should be two separate words. Appropriate correction is required.

### ***Double Patenting***

2. Claims 8, 18, 19, 27, 29, 30, 33, 34, 36, and 37 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 7, 9, 26, 28, and 35. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

For claims 8 and 9, the only difference in wording is that claim 8 sets forth a "cured product" and claim 9 sets forth a "coating film". This slight difference in wording in the preamble does not lead to any appreciable difference in the subject matter claimed in the body of the claim. For claims 19 and 20, these claims possess the

difference in wording as described between claims 8 and 9. In addition, both claims 19 and 20 claim a product obtained by the method of claim 5. The method of claim 5 is directed to forming the same coating composition of claim 1. Therefore, it is the examiner's position that the products claimed in claims 19 and 20 are substantial duplicates of those claimed in claims 8 and 9. In sum, the products claimed in claims 8, 19, and 20 are substantial duplicates of the product claimed in claim 9.

For claims 27 and 28, the only difference in wording is that claim 27 sets forth a "cured product" and claim 28 sets forth a "coating film". This slight difference in wording in the preamble does not lead to any appreciable difference in the subject matter claimed in the body of the claim. For claims 29 and 30, these claims possess the difference in wording as described between claims 27 and 28. In addition, both claims 27 and 28 claim a product obtained by the method of claim 21. The method of claim 21 is directed to forming the same coating composition of claim 2. Therefore, it is the examiner's position that the products claimed in claims 29 and 30 are substantial duplicates of those claimed in claims 27 and 28. In sum, the products claimed in claims 27, 29, and 30 are substantial duplicates of the product claimed in claim 28.

For claims 34 and 35, the only difference in wording is that claim 34 sets forth a "cured product" and claim 35 sets forth a "coating film". This slight difference in wording in the preamble does not lead to any appreciable difference in the subject matter claimed in the body of the claim. For claims 36 and 37, these claims possess the difference in wording as described between claims 34 and 35. In addition, both claims 36 and 37 claim a product obtained by the method of claim 22. The method of claim 22

is directed to forming the same coating composition of claim 10. Therefore, it is the examiner's position that the products claimed in claims 36 and 37 are substantial duplicates of those claimed in claims 34 and 35. In sum, the products claimed in claims 34, 36, and 37 are substantial duplicates of the product claimed in claim 35.

For claims 7 and 18, claim 18 claims a product obtained by the method of claim 5. The method of claim 5 is directed to forming the same coating composition used in claim 7. Therefore, it is the examiner's position that the product claimed in claim 18 is a substantial duplicate of the product claimed in claim 7.

For claims 26 and 33, claim 26 claims a product obtained by the method of claim 21. The method of claim 21 is directed to forming the same coating composition used in claim 33. Therefore, it is the examiner's position that the product claimed in claim 33 is a substantial duplicate of the product claimed in claim 26.

***Allowable Subject Matter***

3. Claims 8, 9, 18 19, 27, 29, 30, 33, 34, 36, and 37 would be allowable if rewritten or amended to overcome the objections set forth in this Office action.

4. Claims 1, 2, 4, 5, 7, 9-17, 20-26, 28, 31, 32, and 35 are allowed. Please note that normally in the case of claims that are substantial duplicates, the claim that comes first numerically is normally allowed. However, in this case, since claims 8, 27, and 34 are objected to for other reasons as set forth above, claims 9, 28 and 35 are allowed because they are the first allowable claims in the respective series of duplicates.

***Conclusion***

5. The examiner apologizes for his oversight in not pointing out these potential double patenting problems in the previous office action. This action is non-final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (703) 306-5929. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Dawson can be reached on (703) 308-2340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

*Jeffrey B. Robertson*  
Jeffrey B. Robertson  
Primary Examiner  
Art Unit 1712

JBR